UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,522	07/26/2001	Jin-Kwan Kim	8071-174T	6306

22150 7590 08/14/2008

F. CHAU & ASSOCIATES, LLC
130 WOODBURY ROAD
WOODBURY, NY 11797

EXAMINER	
WASSUM, LUKE S	

ART UNIT	PAPER NUMBER
2167	

MAIL DATE	DELIVERY MODE
08/14/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	09/912,522	KIM ET AL.	
	Examiner	Art Unit	
	Luke S. Wassum	2167	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 August 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *1 and 3-18*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
    See Continuation Sheet.

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

/Luke S. Wassum/
Primary Examiner
Art Unit 2167

Continuation of 11. does NOT place the application in condition for allowance because:

The Applicants' arguments have been considered, but are not persuasive.

Regarding the argument that the claim rejections under 35 U.S.C. 101 are improper, the examiner respectfully disagrees.

The Applicants argue that since their claimed invention produces a useful, concrete and tangible result, the claims are statutory, consistent with the Federal Circuit's decisions in State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F.3d 1368 (1998) and A T & T v. Excel Communications Inc., 172 F.3d 1352 (1999).

However, a complete 101 analysis begins with the consideration as to whether a claim falls within a statutory category of invention. Only after it has been established that the claim falls within a statutory category of invention does the analysis proceed to consider whether the claim includes a judicial exception, and then on to consideration of whether the judicial exception is practically applied by producing a useful, concrete and tangible result.

The examiner agrees that the claims at issue (when executed on a computer) would produce a useful, concrete and tangible result, but since the claims are drawn to software per se, they fail to fall within a statutory category of invention, as software is not a machine, manufacture, composition of matter nor a process, and so the 101 analysis never proceeds to the consideration of whether the claim produces a useful, concrete and tangible result.

The examiner notes that the claims at issue in the State Street Bank decision were drawn to a machine ('A data processing system…comprising computer processing means [a personal computer including a CPU] for processing data…'). As such, the claim fell within a statutory category of invention under 35 U.S.C. 101.
Similarly, the claims at issue in A T & T were drawn to a process ('A method for use in a telecommunications system…'), and so also fell within a statutory category of invention.

In contrast, the Applicants' claim is drawn to software per se, since it is claimed as a system ('A computer-based system for analyzing and utilizing intellectual property (IP) information…') whose limitations are all drawn to software. Such a claim fails to fall within a statutory category of invention, and is therefore unpatentable under 35 U.S.C. 101.

The claim rejections under 35 U.S.C. 101 are maintained.

Regarding the Applicants' arguments that the limitations of claims 1, 4 and 11 are not met by the Unger et al. reference, the examiner respectfully disagrees.

The Applicants' argue that the Unger et al. reference fails to teach transmitting the first and second IP information to a research center analyzing unit. The examiner points out that the Unger et al. reference discloses that IP information can be displayed on a computerized graphical interface (col. 3, lines 46-51), said computerized graphical interface being interpreted by the examiner as the claimed research center analyzing unit. In order for the IP information to be displayed in the interface, the IP information must first be transmitted thereto.

The Applicants argue that the Unger et al. reference fails to teach extracting second IP information corresponding to the first IP information upon a request for detailed information. The examiner points out that the Unger et al. reference discloses that the specific details on documents, abstracts and claims can be linked to full-text sources of the documents (col. 2, lines 40-46), and that electronic full-text sources may be accessed on the Internet to display the full text and associated graphics of the associated patents (col. 6, lines 48-53), said full-text sources of the documents being interpreted by the examiner as the claimed second IP information corresponding to the first IP information.

The Applicants argue that the Unger et al. reference fails to teach determining if third IP information has been received from the research center analyzing unit, the third IP information including technical analyses and opinion contents. The examiner points out that the Unger et al. reference discloses that a matrix of expert opinions representing the cumulative opinion of a group of expert technical staff and/or scientists is received and stored (col. 10, lines 40-48), the matrix of expert opinion being interpreted as the claimed technical analyses and opinion contents. The examiner notes that making a determination of whether said expert opinion has been received would be a prerequisite to the storage of such information.

The claim rejections under 35 U.S.C. 103 are maintained.